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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,325	07/26/2000	JOHN S. YATES JR.	114596-28-0053BS	7939

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EXAMINER

ELLIS, RICHARD L

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/626,325

Applicant(s)

YATES ET AL.

Examiner

Richard Ellis

Art Unit

2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-30 is/are allowed.
- 6) ☒ Claim(s) 31-33,35 and 37-43 is/are rejected.
- 7) ☒ Claim(s) 34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

R1

1. Claims 1-43 remain for examination.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.
3. The amendment filed May 2, 2005 is objected to under 35 USC § 132 because it introduces new matter into the specification. 35 USC § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the entire newly inserted text on page 2 of applicant's amendment.

Applicant is required to cancel the new matter in the response to this Office action.

Applicant's arguments cites *Schering Corp. v. Amgen, Inc.* as support for allowing applicant to make the amendment to the specification and at the same time avoid the new matter bar of the statute. However, had applicant actually read the cited court case, he would have found this quotation therein:

"The fundamental inquiry is whether the material added by amendment was inherently contained in the original application. ... To make this judgment, this court has explained that the new matter prohibition is closely related to the adequate disclosure requirements of 35 U.S.C. Section 112. ... Section 112, in turn, requires: 'a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms *as to enable* any person skilled in the art . . . to make and use the same.' 35 U.S.C. Section 112 (1194) (emphasis added). Thus, to avoid the new matter prohibition, an applicant must show that it's original application supports the amended matter." (*Schering Corp. v. Amgen Inc.*, 55 USPQ2d 1650, citations omitted, emphasis added.)

Applicant's argument merely cites this case and states that it gives him the supposed right to ignore the clear prohibition against new matter entry by amendments. Applicant's amendment has, however, completely failed to show that it's (applicant's) original application supports the amended matter, which is a requirement clearly set forth by the cited case. Accordingly, as applicant has failed to show how its original application supports the amended matter, the amended matter is therefore new matter and must be canceled from the specification. Furthermore, had applicant's original application supported the newly amended text, there would have been no need for applicant to attempt to insert new matter in clear

violation of the requirements of the statute. Applicant could simply have referenced those portions of the specification which supported this amended material. Therefore, because applicant failed to point to the portions of the specification which support the amended material, there must therefore be no portion of the specification which supports the material (otherwise applicant would have simply pointed to that portion) and therefore, the material is also new matter.

4. Claims 31-33, 35, 37-38, and 40 are rejected under 35 USC 102(e) as being clearly anticipated by Hammond et al., U.S. Patent 5,774,686.

5. Claims 39 and 41-43 are rejected under 35 USC § 103 as being unpatentable over Hammond et al., as applied to claims 31-33, 35, 37-38, and 40, supra., in view of Thomas, U.S. Patent 5,386,563.

Hammond et al. was cited as a prior art reference in paper number 20041027, mailed October 27, 2004.

6. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 20041027, mailed October 27, 2004.

7. Applicant's arguments filed May 2, 2005, paper number 20050502, have been fully considered but they are not deemed to be persuasive.

8. In the remarks, applicant's argument in support of the claims is that the newly added definition (which has been shown to be new matter above) of the terms thread and process clearly show that the reference does not read upon the claims.

Applicant's arguments are not persuasive for several reasons:

1) Applicant's newly added definition is new matter as explained above. By virtue of the fact that it is new matter, the new definition is not present in the application as filed, and applicant is barred by 35 USC § 132 from now adding that definition to the specification. Since that definition therefore forms no part of the original specification, the claims can not be narrowed by that definition in the specification to result in them potentially overcoming the cited prior art. Furthermore, were this definition to have existed in the original specification,

there would have been no need for applicant to now attempt to narrow the claim language by amending the specification, giving further evidence to the fact that the amended definition is in fact new matter to the specification.

2) Assuming that applicant were able to correct his clear error in submitting an amendment containing new matter without providing a required clear showing of how the original filed specification supported that amendment, the amended text would remain ineffective in narrowing the claims to potentially overcome the applied reference. This is because in both applicant's argument and in the new definition, applicant points out numerous times that he is using the "ordinary and customary" meaning of those terms:

"The terms 'process' and 'thread' are used herein in their ordinary and customary, though formal, senses, as actually used in the programming language systems, operating systems, and processor architecture arts.";

"the definitions of the terms 'thread' and 'process' added by amendment are intended only to emphasize the reliance on the meanings in ordinary and actual use in the computer architecture, operating systems, and programming language arts,";

"The definition of 'thread' in the specification merely states the ordinary understanding in the art";

One of the definitions cited to applicant, and one of the definitions actually used in the last rejection was the definition given for thread and process by the Microsoft corporation. There can not possibly be a better indication of the "ordinary and customary", "ordinary and actual use", or "ordinary understanding" of the meaning of the terms thread and process than that published by the worlds largest supplier of programming language systems and of operating systems. Therefore, even assuming that the amended definitions were not new matter, they would remain ineffective because the definition relied upon is the most ordinary, most customary, and best understood definition for the terms which can possibly exist.

3) As applicant should be fully aware, the specification can be relied upon to provide meaning to a term in a claim, but applicant may not import limitations from the specification into the claim. Applicant's arguments are attempting to import additional limitations (one of "independent" execution) into the claims without actually amending the claims to contain that

limitation. Accordingly, as applicant can not import limitations from the specification into the claims, even if the amendment to the specification were not to be new matter, it would not provide any additional limitations to the claim language which may or may not overcome the cited reference.

4) Applicant states an intent that the amendment to the specification is not narrowing to the claims:

"The definition of "thread" in the specification merely states the ordinary understanding in the art, and has no effect on the scope of the claims."

If such a statement were true, there would be no need for the amendment to help overcome the cited art. Accordingly, because by applicant's own admission, the specification amendment does not effect the scope of the claims, and because the current scope of the claims is so exceedingly broad that it infringes upon the cited references, the claims are not patentable in view of the cited references.

9. Claims 34 and 36 are objected to as being dependent upon a rejected base claim, but would render the base claim allowable if bodily incorporated into the base claim such that the new base claim included all of the original limitations of the base claim, any intervening claims, and the objected claim.

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (571) 272-4165. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (571) 272-4162. The fax phone number for this Group is: (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Richard Ellis
July 14, 2005



RICHARD L. ELLIS
PRIMARY EXAMINER